

Appl. No. : 10/726,110
Applicant : Gary Searle
Filed : December 2, 2003
TC/A.U. : 3731
Examiner : WEBB, SARAH K
Docket No. : 03-062-GS

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**APPLICANT'S REPLY TO THE EXAMINER'S
ANSWER TO APPLICANT'S APPEAL BRIEF**

Sir or Madam:

Please find enclosed Applicant's Reply to the Examiner's Answer to Applicant's Appeal Brief, in support of the above-referenced application.

ARGUMENT

Claim Rejections – 35 USC §102

The Examiner rejected claims 76 and 77 under 35 USC §102 as being anticipated by U.S. Patent No. 6,517,575 issued to Yang et al.

Applicant incorporates by reference all arguments stated in Applicant's appeal Brief and the arguments lodged herein are meant only to augment the matter in the Appeal Brief and not to

be substituted for the matter stated in said Appeal Brief. In the Appeal Brief, in addressing the 35 USC §102 rejection of claims 76 and 77 applicant, in addition to stating that the elements of claims 76 and 77 are not fully present in Yang, applicant additionally asserted that Yang does not disclose a device which is used for the same purpose as applicants invention of claims 76 and 77 (Examiner's Answer, p. 7, **(10) Response to Argument**, ¶1). In opposition to applicant's argumentative matter, the Examiner has stated "[n]either of these claims is limited to an occlusion device (Examiner's Answer, p. 7, **(10) Response to Argument**, ¶1). Applicant asserts that not only is Examiner's rejection and reasoning counterintuitive, Examiner's stated position additionally serves to support applicant's contentions. As illustrated herein, since well-established tenets hold that claims must be read, interpreted and construed in light of the specification for which the claims are drawn from, in conjunction with the fact that no structure disclosed in Yang can encompass an occluding device, applicant asserts that Yang cannot serve as an anticipation reference or even a reference for obviousness purposes.

Claims must be read in view of the specification, of which they are part. *SciMed Life Systems, Inc. v. Advanced Cardiovascular*, 242 F.3d 1337, 1340 (Fed. Cir. 2001). Where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question. See *Id.* at 1341. "When the preferred embodiment is described as the invention itself, the claims are not entitled to a broader scope than the embodiment." *Id.*

"Whether an invention is fairly claimed more broadly than the 'preferred embodiment' in the specification is a question specific to the content of the specification, the context in which the embodiment is described, the prosecution history, and the prior art" *Teleflex, Inc. v. Ficosa*

North America Corp., 299 F.3d 1313, 1326 (Fed. Cir. 2002). "Claims should be interpreted consistently with the specification, which provides content for the proper construction of the claims because it explains the nature of the patentee's invention" *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 102 F. Supp. 2d. 199, 209 (D. Del. 2000). "[C]laims should not be construed to encompass embodiments beyond those that are described and enabled in the specification" *Id.* at 215.

Thus, Applicant has repeatedly illustrated that the entire premise of instant invention surrounds an occluding mechanism for performance of the required function. Therefore, as definitely illustrated throughout prosecution and within applicant's Appeal Brief, the invention as defined in claims 76 and 77, and for the entirety of the specification for that matter, encompasses an occluding device.

Furthermore, as illustrated throughout prosecution of the application at issue, the features of claims 76 and 77 present markedly differing structural limitations, not disclosed in Yang. Additionally, the differing purpose for use of applicant's invention only serves to bolster applicant's assertions. As illustrated at length in the Appeal Brief and prosecution history, the Yang disclosure is simply is not capable of performing the occluding function so vital to applicant's invention as claimed. The physical structure disclosed in Yang simply prohibits the device from occluding and in fact, the word occluding is not even mention within the disclosure of the Yang patent.

Thus, as of the structural limitations of claim 76 and 77 are not met applicant rests on the contention that the rejections under 35 USC § 102 should not stand.

Claim Rejections – 35 USC §103

The Examiner rejected claims 1, 4, 5, 9-14, 16, and 19-23 under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,458,152 issued to Khosravi et al. in view of Yang.

Applicant incorporates by reference all arguments stated in Applicant's appeal Brief and the arguments lodged herein are meant only to augment the matter in the Appeal Brief and not to be substituted for the matter stated in said Appeal Brief. When considering obviousness of a combination of known elements, the operative question is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions. *Teleflex Inc. v. KSR Int'l Co.*, 550 U.S. ___, 82 USPQ2d 1385, 1386 (2007). For the following reasons, the results achieved by applicants invention as claimed, which do not qualify as readily predictable from the combination of the references supplied by the Examiner, herein mandate that the obvious rejections should be removed.

In light of modern interpretations of the obviousness standard, the rationale advanced by the Examiner for the obviousness rejection is incorrect as Wang actually teaches away from the instant invention. The Examiner states, "Yang **teaches** that this type of prosthesis should include an expandable filler material **bonded** to another thin sheet. (Examiner's Answer, p. 5, ¶ 2) (emphasis added). Under the recently revised standards, the rationale to support a conclusion that the claim would have been obvious is that "a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success." *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 1006). As stated throughout prosecution, no teaching exists in the disclosure of either patent to assist one of skill in the art to achieve the required construction.

Thus, despite of the verbiage disclosed by the Yang reference in conjunction with the fact that the polymer material utilized in Yang expands, the device as disclosed merely deflects. In fact, as wholly illustrated in prosecution, if the Yang device was configured to performed similarly to the instant invention, the Yang device would not provide the function for which Yang is intended and no diversion from said function is taught in Yang. Further, the combination of the invention of Koshravi in light of Wang does not yield a workable system and certainly not a system which features non-bonding. This form of differentiation insight is apparent and attributable to one of ordinary skill in the art as the cited references do not broach the non-bonding configuration.

Investigation of the specification of the instant invention reveals that the preferred embodiment disclosed is one where non-bonding of the must occur. Claims must be read in view of the specification, of which they are part. *SciMed Life Systems, Inc. v. Advanced Cardiovascular*, 242 F.3d 1337, 1340 (Fed. Cir. 2001). Where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question. See *Id.* at 1341.

"Whether an invention is fairly claimed more broadly than the 'preferred embodiment' in the specification is a question specific to the content of the specification, the context in which the embodiment is described, the prosecution history, and the prior art" *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1326 (Fed. Cir. 2002). "Claims should be interpreted consistently with the specification, which provides content for the proper construction of the claims because it explains the nature of the patentee's invention" *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 102 F. Supp. 2d. 199, 209 (D. Del. 2000). "[C]laims should not be construed to

encompass embodiments beyond those that are described and enabled in the specification" *Id.* at 215.

Moreover, Koshravi discloses a member disposed on the interior of the stent body. Therefore, once again, the instant claims herein must be afforded interpretation of the non-bonding embodiment as the casein is not in contact with or bonded to the inside of the stent. Ergo, as the claims of applicant's invention are clearly encompass as a preferred embodiment, and as no teaching exists in the disclosure of either of the cited patents to assist one of skill in the art to achieve the required construction, the obviousness rejection, under the "teaching" rational asserted by the Examiner cannot stand, in view of the modern interpretation.

Further, the Examiner states, "Khosravi discloses a rolled sheet self-expanding stent." (Examiner's Answer, p. 4, **(9) Grounds of Rejection, ¶ 5**) Applicant asserts that applicant's stent disclosed in the instant application acts as a scaffold for the device and thus is out of the realm of Khosravi. Thus, as Khosravi exists within a differing technology and possesses no teaching toward applicant's device, applicant asserts that the Examiner constructed the obviousness rejection through hindsight. It is impermissible to use the claimed invention as an instructional manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F. 2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992)(quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)). The Federal Circuit has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.* Therefore, the obviousness rejections involving Khosravi as a reference should not be upheld.

Further in the instant invention, an extruded seamless tube of casein is placed inside a separate spirally wound thin sheet, and when exposed to fluid in the body lumen, the tube of casein would expand and provide the same function as if the two were bonded together. This is not the case with Yang's invention. Two sketches illustrating how the instant invention operates when the casein isn't bonded to the thin foil are attached as Exhibit 1. Two methods for such manufacture are as follows: (1) wind separate spirals of the casein and foil; or, (2) extrude a hollow cylinder (tube) of casein and place that inside the spirally wound foil.

Reconsideration and further examination is respectfully requested. The Commissioner is hereby authorized to charge any additional fees, which may be required for this amendment, or credit any overpayment to Deposit Account No. 12-0115.

Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Gary E. Lambert, Applicant's Attorney at (617) 720-0091 so that such issues may be resolved as expeditiously as possible.


For these stated herein and in view of the above remarks and arguments, Applicant asserts that this application is now considered to be in condition for allowance and such action is earnestly solicited. Applicant respectfully contends that all rejected claims are patentable.

Therefore, reversal of all rejections is courteously solicited.

Respectfully Submitted,

Date: 11/13/2007

Respectfully submitted,



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